

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 059864.01052
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/517,442
	Filed: December 23, 2004
	First Named Inventor: Juha KALLIO
	Art Unit: 2617
	Examiner: Naghmeh MEHRPOUR

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
Registration No. 58,959

☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____

Signature

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Telephone number

May 14, 2008

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 5666

Juha KALLIO

Art Unit: 2617

Application No.: 10/517,442

Examiner: Nahgmeh MEHRPOUR

Filed: December 23 ,2004

Attorney Dkt. No.: 059864.01052

For: DOWNLOADABLE PROFILES FOR MOBILE TERMINALS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 14, 2008

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the Official Gazette Notice of July 12, 2005, Applicant hereby submits this Pre-Appeal Brief Request for Review of the final rejections of claims 28-58 in the above identified application. Claims 28-58 were finally rejected in the Office Action dated January 14, 2008. Applicant filed a Response to the Final Office Action on April 4, 2008, and the Office issued an Advisory Action dated May 2, 2008, maintaining the final rejections of claims 28-58. Applicant hereby appeals these rejections and submits this Pre-Appeal Brief Request for Review.

Claims 28-52 and 54-58 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,068,189 of Brescia et al. (Brescia). Applicant submits that there is clear error regarding the alleged anticipation of at least one element of claims 28, 41, 54, and 58 upon which claims 29-40, 42-52, and 55-57 are dependent. Thus, withdrawal of the rejection is respectfully requested.

Brescia generally describes delivering information, such as a notification or other content, to a select communication device when defined event and location criteria are satisfied. A profile is established to define the event and location criteria along with a method for delivering the information. Specifically, Brescia states "a profile that defines information to provide to a select device is transmitted, when predefined events and location indicia are

satisfied, wherein the profile is stored on an application server.” See column 4, lines 46-50, of Brescia.

Thus, the “profile” is sent to an application server and not to a device. Further, the “information” that is sent to a select device, such as a notification or other content, is not a “profile” as defined in the present claimed invention. Thus, according to Brescia, the profile is not sent to a device, only the resulting “information”, if a match occurs. The “information” sent to the user device is a “simple notification, preselected-content, or a combination thereof” and not a profile. See column 4 lines 48-50, of Brescia.

It is respectfully submitted that Brescia fails to disclose or suggest at least the feature of transmitting said profile to said mobile terminal, as recited in claim 28 and similarly recited in claims 41, 54, and 58. Brescia merely discloses sending “information” to the appropriate device, if the event occurrence and location indicia match the event and location criteria. These deficiencies in Brescia constitute clear error in the rejection.

In the “Response to Arguments” section, the Office Action appears to appreciate the difference between a “profile” and “information” as described in Brescia. However, the Office Action also asserted that the information transmitted to the device, may optionally include a profile. The Office Action’s position inappropriately ignores the meaning of the term “profile” as defined in the present application and inappropriately reads features into Brescia that are not described therein.

For example, the feature “profile” as clearly recited in the present claims and described in the specification, is directed to customized affects such as the “look and feel” of the user device. This “profile” feature is clearly described in the present specification at least in paragraphs [0002], [0004], [0006], [0033], [0038], and [0039] of the published present application.

MPEP 2111.01 (IV) describes that “where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings”). In this case, the word “profile” is defined in the specification. Therefore, the Examiner must accept Applicants’ definition.

MPEP 706 IV and 37 CFR 1.112 describe that “after reply by applicant or patent owner (1.111 or 1.945) to a non-final action and any comments by an inter partes reexamination requester (1.947), the application or the patent under reexamination will be **reconsidered and again examined.**” (Emphasis Added). As noted above, the rejection does not satisfy the requirement set forth under MPEP 706 (IV) and 37 CFR 1.112. Furthermore, because no meaningful response to the above distinctions has been presented, the burden has not yet shifted to Applicants to establish an unobvious difference. However, if such were required, the above explanation of the difference between what is claimed, and what the Office Action asserted was inherently taught should suffice to carry Applicants’ burden.

Further, the Office Action’s explanation reads features into Brescia that are neither disclosed nor suggested therein. For example, the Office Action alleged that Brescia describes “transmitting the profile to the mobile, the information is sent to the selected device, not the server”. However, Applicant respectfully submits that this description is nowhere to be found in Brescia, and is an unreasonably broad interpretation of what is actually disclosed therein.

MPEP 704.14(b) describes that “the **Examiner must consider the information submitted with Applicants’ reply** and apply the information as the Examiner deems appropriate. This obligation arises from the Examiner’s assertion that the information is necessary to the examination in making the requirement. Information constituting identification of areas of search must be considered and the examiner must indicate which areas were used and which areas were not used in performing a search. This indication may be placed in the file wrapper search notes, or may be made by notations on the applicant’s reply, with the examiner’s initials and date, and with a notation in the file wrapper search notes that searching based on the 37 CFR 1.105 requirement was made according to the notes on the applicant’s reply.” (Emphasis Added).

In the Applicant’s previous reply, Applicant submitted that the description of “transmitting the profile to the mobile, the information is sent to the selected device, not the server” is nowhere to be found in Brescia. However, the Office Action failed to consider Applicant’s reply, and the Office Action did not provide any reasons why Brescia does not fail to disclose or suggest this feature. Thus, this error should be deemed admitted.

Further, Applicant respectfully submits that Brescia fails to disclose or suggest at least the feature of "determining profile reception capabilities of a mobile terminal," as recited in claims 28, 41, 54, and 58. Applicant respectfully submits that Brescia is silent with regards to this feature. In Brescia the information is transmitted to the device without a determination being made as to the device's capabilities.

On page 3, the Office Action took the position that column 3, lines 5-59, of Brescia describes "determining profile reception capabilities of a mobile terminal." However, the cited portion merely describes that the email server is capable of sending email to devices receiving email via the circuit-switched networks 14. Brescia does not disclose or suggest any determining profile reception capabilities of a mobile terminal. Thus, Brescia fails to disclose or suggest, at least, "determining profile reception capabilities of a mobile terminal," as recited in claims 28, 41, 54, and 58.

Based at least on the above, Applicant submits that Brescia fails to disclose or suggest all of the features recited in claims 28, 41, 54, and 58. Accordingly, Applicant respectfully submits that the rejection under 35 U.S.C. 102(e) is clearly erroneous. Withdrawal of this rejection is respectfully requested.

Furthermore, Brescia is silent regarding the feature of determining the capabilities of the mobile terminal to install a particular profile as recited in certain of the presently pending claims. These deficiencies in Brescia constitute clear error in the rejection.

Claims 29-40, 42-52, and 55-57 are dependent upon claims 28, 41, and 54. Accordingly, claims 29-40, 42-52, and 55-57 should be allowed for at least their dependence upon claims 28, 41, and 54, and for the specific limitations recited therein.

Claim 53 was rejected under 35 U.S.C. 103(a) as being unpatentable over Brescia in view of U.S. Patent No. 7,249,100 of Murto et al. (Murto). The Office Action asserted that Brescia and Murto describe all of the features of claim 53. Withdrawal of the rejection is respectfully requested.

Murto generally describes a system and method for enabling a mobile phone or wireless PDA to discover Internet business and services by accessing the Universal Description, Discovery and integration (UDDI) registry using a user's location or coordinates. However, Murto does not cure the above-identified deficiencies in Brescia. Thus, Applicant respectfully

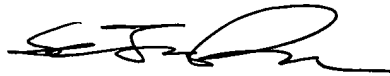
submits that Murto and Brescia fail to disclose or suggest all of the elements of claim 41. These deficiencies in Brescia and Murto constitute clear error in the rejection.

Claim 53 is dependent upon claim 41. Accordingly, claim 53 should be allowed at least for its dependency upon claim 41, and for the specific limitations recited therein.

For the reasons explained above, it is respectfully submitted that each of claims 28-44, 46-54, and 56-58 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 28-44, 46-54, and 56-58 be allowed, and that this application be passed to issue.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form
Notice of Appeal
Petition for Extension of Time
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